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EXAMINER

RAMANA, ANURADHA

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

DEC 07 2006

Group 3700

Application Number: 10/623,179
Filing Date: July 18, 2003
Appellant(s): BERG ET AL.

Peter J. Ims
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on September 9, 2006 appealing from the Office action mailed on March 1, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The summary of claimed subject matter contained in the brief is deficient because of the following minor typographical errors:

- 1) the references to the specification by page and line number are incorrect. On page 6, line 7 of Appellant's brief, page 4 of Appellant's specification should be referenced instead of page 14.
- 2) the drawings are not referred to by Figure Numbers.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,373,709	Whitt	02-1983
4,813,401	Grieshaber	03-1989
5,964,698	Fowler	10-1999
6,190,312	Fowler, Jr.	02-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Whitt (4,373,709).

Whitt discloses a surgical limb holder 10 that can be used to hold a limb in any position, the holder mounted to a surgical table having a support 11, arms 29 and a flexible strap 40 that can be used to restrain a lower portion of a leg or "lower leg" (Figs. 1 and 3, col. 1, lines 19-21 and col. 2, lines 18-39).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler, Jr. (US 6,190,312) in view of Fowler (US 5,964,698) and Grieshaber (US 4,813,401).

Fowler, Jr. discloses a conventional or variable geometry retractor frame or "retractor support" with arms 12a and 12b and a retractor stay apparatus or "retractor" attached to an elastic member wherein the elastic member is received in a notch of a member attached to the frame (Fig. 1, cols. 4 and 5 and col. 8, lines 11-28).

Fowler, Jr. discloses all elements of the claimed invention except for: (1) a retractor stay apparatus such as a blade; and (2) the conventional frame being mounted to a surgical table.

Retractor stay members such as paddles or "blades" and hooks attached to elastic members are well known as illustrated by Fowler (Fig. 6 and col. 1, lines 44-52).

Grieshaber teaches supporting a conventional retractor frame by mounting it on an operating or surgical table via a rail B (Fig. 1, cols. 5 and 6).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided retractor stay members or retractors such as blades in the Fowler, Jr. apparatus since such stay members are well known in the art for retracting tissue, as demonstrated by Fowler. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have mounted the retractor apparatus of the combination of Fowler, Jr. and Fowler to an operating table, as taught by Grieshaber as it is common knowledge in the retracting art to support a conventional retractor frame by mounting it to a surgical table.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitt (US 4,373,709).

Whitt discloses that limb holder 10 can be utilized in any position that will enhance and facilitate surgery (col. 1, lines 6-22). See previous discussion for claim 19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the limb holder 10 to restrain the lower leg or "tibia" to provide support without discomfort.

The method steps of claims 17 and 18 are rendered obvious by the above discussion.

(10) Response to Argument

In response to Appellant's arguments with respect to the rejections of claim 9-16 under 35 USC 103(a) as being unpatentable over Fowler, Jr. (US 6,190,312) in view of Fowler (US 5,694,698) and Grieshaber (US 4,813,401), it is noted that Appellant's arguments are directed only to the rejection of independent claim 9.

In response to Appellant's argument that there is no suggestion to combine the references (pages 8 and 9 of Appellant's Brief), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In order to establish a prima facie case of obviousness, the following three basic criteria must be met (MPEP 2143).

1. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings.
2. Second, there must be a reasonable expectation of success.
3. Finally, the prior art references when combined must teach or suggest all claim limitations.

Contrary to Appellant's assertions (page 10, lines 19-28 and page 11, lines 1-15 of Appellant's Brief), Fowler, Jr. discloses the use of a retractor stay apparatus or retractor in the form of a hook attached to a conventional retractor frame or retractor support or a variable geometry frame or retractor support by an elastic member (Figures 1 and 14 and col. 6, lines 44-53). In making this rejection, the Examiner has used the disclosure in Fowler, Jr. of the use of a retractor stay apparatus attached to a conventional retractor frame by an elastic member.

Fowler demonstrates that it is very well known in the art to use a retractor stay apparatus such as a paddle or "blade" 70 or a hook 58 (Figures 1 and 6, col. 3, lines 9-44 and col. 5, lines 46-64). Thus, there would be reasonable expectation of success to attach a retractor stay apparatus such as a blade to a conventional frame by means of an elastic member.

Thus, the combination of Fowler, Jr. and Fowler discloses all elements of the claimed invention except for the conventional retractor frame or retractor support being mounted on a surgical table.

Grieshaber teaches supporting a conventional retractor frame, available in a variety of sizes and configurations to suit the particular surgical procedure to be performed, by attaching the retractor frame to a rail B of a surgical table in order to

maintain the retractor frame at a desired elevation above the incision site (Figure 1 and columns 5 and 6).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have mounted the conventional retractor frame or retractor support of the combination of Fowler, Jr. and Fowler, to a surgical table via a rail B, as taught by Grieshaber, for purposes of supporting the retractor frame, at a desired elevation above an incision site, during a surgical procedure.

It is noted that the device of the combination of Fowler, Jr., Fowler and Grieshaber is fully capable of performing the functions recited in claim 9.

Therefore, the rejections of claims 9-16 under 35 USC 103(a) as being unpatentable over Fowler, Jr. in view of Fowler and Grieshaber is proper.

In response to Appellant's arguments with respect to the rejection of claim 19 under 35 USC 102(b) as being anticipated by Whitt (US Patent No. 4,373,709) (see page 11, lines 24-29 and pages 12-13 of Appellant's Brief), it is noted that Appellant's arguments are not directed to claimed features.

Whitt discloses an apparatus for securing the lower leg in knee surgery including a retractor support 11 mounted to a surgical table wherein retractor support 11 has arms 29 and a flexible strap 40 is used to restrain or hold a lower leg (Figures 1 and 3).

Whitt clearly discloses that his invention is readily adjustable to a great variety of positions and attitudes so that a limb can be held in any position that will enhance and facilitate surgery (col. 1, lines 5-22 and lines 37-56). As shown, in Figure 1, arms 29 are shown extending on opposite sides of the knee and engaging a lower leg portion wherein strap 40 restrains the lower leg portion between arms 29 while holding the knee in a bent position. It is noted that when strap 42 is tightened, it is capable of applying a generally downward force on the leg by pushing against the leg.

Appellant argues that strap 40 would obstruct access to the knee joint and prevent or hinder the surgical procedure (page 13, lines 1-4 of Appellant's Brief). It is noted by the Examiner that claim 19 does not either structurally or functionally recite

any limitations relating to access to the knee joint or permitting surgery thereon. Thus, Appellant's arguments are not directed to claimed features.

It is also noted that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Therefore, the rejection of claim 19 under 35 USC 102(b), as being anticipated by Whitt, is proper.

In response to Appellant's arguments with respect to the rejections of claims 17 and 18 under 35 U.S.C 103(a), as being unpatentable over Whitt (US 4,373,709) (pages 14-15 of Appellant's Brief), it is noted that Whitt discloses that his apparatus is adjustable to various heights and to various size limbs and provides a variety of angles that are needed for diagnostic and surgical arthroscopy (col. 1, lines 5-22 and lines 37-56). The Whitt apparatus is used to hold a knee, in an elevated and bent position, facing generally upwardly (see Fig. 1 of Whitt).

As previously stated, to establish a prima facie case of obviousness, the following three basic criteria must be met (MPEP 2143).

1. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.
2. Second, there must be a reasonable expectation of success.
3. Finally, the prior art reference must teach or suggest all claim limitations.

The disclosure of Whitt clearly suggests that the limb of a human or animal can be placed in an elevated and bent position for performing surgical arthroscopy (Fig. 1) Whitt also discloses that his apparatus can be used in a variety of positions and attitudes so that a limb can be held in any position that will enhance and facilitate surgery (col. 1, lines 19-22).

Thus, a person of ordinary skill in the art would be motivated to use the Whitt apparatus such that a lower limb of a human or animal is held in a selected position while providing access for a surgical arthroscopic procedure, such as knee joint surgery, to be performed.

Thus, the rejection of claims 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over Whitt is proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

It is noted that the Appeal Brief states that Appendix C includes "Related Proceedings Index" at page 23. However, no such Appendix has been provided.

Since the record is clear that there are no related appeals and interferences, the Examiner is assuming that the appellant meant to include this Appendix with a statement of "None." (MPEP 1205.03).

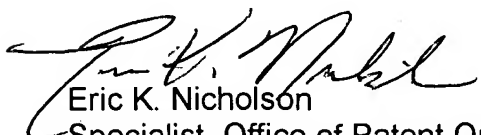
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

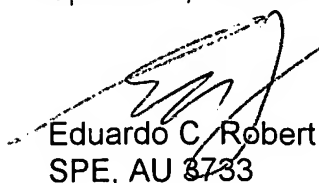


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